

Remarks

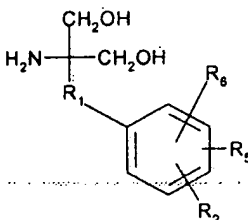
Upon entry of the foregoing amendments, claims 1 to 6, 9 and 10 will be pending. Claims 3 to 5, 9 and 10 are withdrawn. Claims 1 and 4 to 6 have been amended, without prejudice, to place the claims in better form. Claims 7 and 8 have been cancelled, without prejudice. Applicants reserve the right to pursue subject matter that remains after the prosecution of the present application in a future continuing patent application, for example, a division.

Discussion of the Rejections under 35 U.S.C. § 103(a)

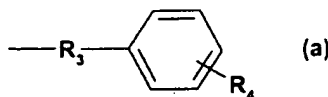
Claims 1, 2 and 6 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2007/0010494 to Ehrhardt et al. ("Ehrhardt"). Without commenting on the merits of the rejection, the present rejection is respectfully traversed as a 35 U.S.C. § 103(a) rejection cannot be made using 35 U.S.C. § 102(e) prior art between commonly assigned applications (see 35 U.S.C. § 103(c)). The Examiner has acknowledged that Ehrhardt is only available as prior art under 35 U.S.C. § 102(e) (Action at 4). Both Ehrhardt and the present application were, at the time the claimed invention was made, owned by, or subject to an obligation of assignment to Novartis AG. In particular, the assignment from the inventors of Ehrhardt to Novartis AG is recorded at Reel 021927, Frame 0777, and the assignment from the inventors of the present application to Novartis AG is attached hereto. Thus, Ehrhardt and the present application have a common assignee and the Section 103(a) rejection is improper.

Claims 1, 2 and 6 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,004,565 to Chiba et al. ("Chiba"). Applicants respectfully traverse this rejection as there is no reason or motivation for a person of ordinary skill in the art at the time of the present invention to modify Chiba in such a way as to obtain any compound of the presently claimed invention.

Applicants' claims define a compound of formula I:

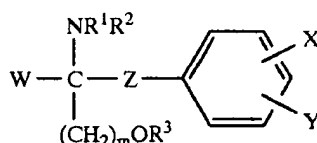


wherein, R₁ is C₂₋₈-alkylene; R₂ is C₁₋₂₀-alkyl, optionally substituted by halogen; R₅ is H or C₁₋₂₀-alkyl; and R₆ is C₁₋₂₀alkyl or a radical of formula a)



wherein R_3 is C_{2-8} -alkylene and R_4 is H or C_{1-20} alkyl, optionally substituted by halogen, in free or salt form (see e.g. claim 1).

In contrast, Chiba teaches benzene compounds of formula:



wherein, in relevant part, W is a straight or branched chain C_{1-6} alkyl substituted by 1 to 3 substituents selected from the group consisting of a halogen, a cycloalkyl, and a phenyl, which may be substituted by hydroxyl, X may be a straight-chain alkyl having carbon atoms in the number of p, and may have a phenyl substituent, wherein the phenyl may have an alkyl substituent; Z may be a straight-chain alkylene having carbon atoms in the number of q; p and q are the same or different and each is an integer of 1 to 20, with the proviso that $6 \leq p+q \leq 23$, R^1 , R^2 and R^3 may be H, m may be 1 and Y may be alkyl (see Chiba at Col. 3, lines 44 to 67 and Col. 4, lines 1 to 40). Chiba at least does not disclose the di-methoxy head group of the presently claimed invention. In particular, Chiba discloses that W may be an alkyl group substituted by a halogen, cycloalkyl or an optionally hydroxyl substituted phenyl. Thus, at least one difference between the claimed invention and Chiba is that the claimed invention requires a di-methoxy head group whereas Chiba may have a methyl group and a methoxy group.

Chiba does not disclose any reason or suggestion that would motivate one of ordinary skill in the art to modify the compounds disclosed therein. To establish a *prima facie* case of obviousness, however, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." (*In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (*In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998)).

The Action appears to link the alleged structural similarity of the compounds of applicants' claimed invention to those disclosed in Chiba in an attempt to establish that claims 1, 2 and 6 are obvious (Action at 8 to 9). As explained above, the difference between the applicants' claimed compounds and those of Chiba is that Chiba does not teach or suggest the presently claimed aminoalkanol derivatives of the present invention. Indeed, Chiba does not disclose at least the di-methoxy head group of the presently claimed compounds or, for example, whether particular benefits would result from such a substituent.

Moreover, although it would have been theoretically possible to modify Chiba in a way that would have produced the claimed invention, much more is required of a reference that is applied in the context of Section 103. The mere possibility that the prior art can be modified or

improved does not itself provide the requisite motivation to do so (*In re Dien*, 152 U.S.P.Q. 550 (C.C.P.A. 1967) (incentive to seek improvement of existing process held to not render change made by applicant obvious, even where the change was one capable of being made from theoretical point of view)). The mere possibility for modification and improvement is not the "motivating force" that the Board and the Federal Circuit have invariably required. If it were, then no modification would ever lack motivation since some change is always possible. It is only with the improper use of hindsight and with the benefit of the applicants' disclosure that one can discern the desirability of the claimed inventions.

Absent the identification of a rationale to modify the compounds of Chiba (as is the case here), a *prima facie* case of obviousness cannot be supported for claims 1, 2 and 6. Accordingly, reconsideration and withdrawal of the rejection are requested respectfully for at least this reason.

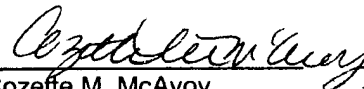
Conclusion

Applicants believe that the foregoing constitutes a complete and full response to the Action of record. If there are any issues that can be resolved by a telephone conference, the Examiner is invited to call the undersigned attorney.

It is hereby requested that the term to respond to the Action of November 17, 2008 be extended pursuant to 37 C.F.R. § 1.136(a) for three (3) months, from February 17, 2009 to May 18, 2009 (May 17, 2009 is a Sunday). The Commissioner is hereby authorized to charge any fees required to Deposit Account No. 19-0134 in the name of Novartis.

Respectfully submitted,

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